UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,526	01/27/2004	Steven Bress		1031

7590　　　　12/27/2006 Steven Bress 7851-C Beechcraft Avenue Gaithersburg, MD 20879	**EXAMINER** DINH, NGOC V
	ART UNIT 2189　　**PAPER NUMBER**

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
	10/765,526	BRESS ET AL.
Office Action Summary	Examiner	Art Unit	
	NGOC V. DINH	2189	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>27 January 2004</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1, 3-9, 12-23</u> is/are rejected.

7) ☒ Claim(s) <u>2,10 and 11</u> is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>27 January 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This office action is a response to the U.S. application Serial No. 10/765526 filed on 01/27/04. Claims 1-23 are presented for examination.

SPECIFICATION

2. The specification is objected to because since the instant application is incorporated by reference the 09/961,417 (now PN. 6,813,682), therefore the followings should be corrected on page 3 of the specification:

a) paragraph [008], Fig. 10 should be restarted with 1 (Fig. 1).

b) paragraph [009], Fig. 11 should be restarted with 2 (Fig. 2).

The Applicant is advised to change every instant of "Fig. 10" and "Fig. 11" to "Fig. 1" and "Fig. 2" in the specification.

DRAWING

3. As mentioned above in the specification, the drawings of Fig. 10 and Fig. 11 should be restarted as Fig. 1 and Fig. 2.

ABSTRACT

4. The abstract of the disclosure is objected to because it contains two paragraphs. The applicant should combine them into only one paragraph. The Applicant should not refer to the other application in the abstract, therefore the Applicant should delete "application 09/961417" on line 3 of the abstract.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written

description requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner requests the Applicant in response to this office action, a showing of support for

the following limitation "there may be a different predetermined set of commands for each

interface emulator". That is, indicate support for claim language by specifically pointing to

page(s) and line no(s) in the specification and/or drawing figure(s). This will assist in

prosecuting the application.

Double Patenting

*6)   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy
(a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to
exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re
Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);
and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or
provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or
patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal
disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).*

*" A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim.
In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were
obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of
obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). "
ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of appeals for the Federal Circuit, ON PETITION FOR
REHEARING EN BANC (DECIDED: May 30, 2001) ".*

Per claims 1-18 and 21-22:

Claims 1-10, 39, 44 of Patent No 6,813,682 contains every element of claims 1, 3-13, 18, 21-23

of the instant application, and as such anticipate claims 1, 3-13, 18, 21-23 of the instant

application, with the exception that:

a) the limitation "multiple interface emulators/ multiple IDE emulator components" (claims 1

and 18), "multiple host computer/multi hosts" (claims 21-22) are rejected under the judicially

created doctrine of obviousness-type double patenting as being unpatentable over Carley US
2003/0233583 [see the rejection by Carley in section 8 below]. It would have been obvious to
one having ordinary skill in the art at the time the invention was made to: a) employ multiple
IDE interface emulator to service multiple hosts into PN. 6,813,682 in order to provide a
flexibility and universal blocking device. The SRMA is a firewall device or a USB device which
has a capability to communicate with any network devices (flexibility and universal).

b) Claims 9, 17 are rejected under the judicially created doctrine of obviousness-type double
patenting as being unpatentable over well-known feature in the art. It would have been obvious .
to one having ordinary skill in the art at the time the invention was made for the same reasons
state in the section 9 below.

c) Claims 12-15 are rejected under the judicially created doctrine of obviousness-type double
patenting as being unpatentable over Kern PN. 6,336,187. It would have been obvious to one
having ordinary skill in the art at the time the invention was made for the same reasons state in
the section 10 below.

d) Claim 16 is rejected under the judicially created doctrine of obviousness-type double
patenting as being unpatentable over Carley. It would have been obvious to one having ordinary
skill in the art at the time the invention was made to combine Carley to PN. 6,813,682 in order to
provide a flexibility and universal blocking device. The SRMA is a firewall device or a USB
device which has a capability to communicate with any network devices (flexibility and
universal).

e) Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting
as being unpatentable over Milliken et al US 2004/0064737. It would have been obvious to one
having ordinary skill in the art at the time the invention was made for the same reasons state in
the section 11 below.

f) Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Watanabe PN 7,050,042. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the same reasons state in the section 12 below.

7. *A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894); In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).*

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Per claims 20:

Claim 25 of Patent No 6,813,682 contains every element of claims 20 of the instant application and as such anticipate claims 20 of the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1, 3-8, 16, 18, 20-22are rejected under 35 U.S.C.102 (e) as being anticipated by Carley US 2003/0233583.

Carley teaches:

Per claims 1, 7-8, 18, 20: a blocking device comprising: **multiple interface emulators** [SRMA (Security Remote Management Appliance) **proxy Firewall** for command line interface, col. 3/[0034]; fig. 1; the proxy Firewall corresponds to multiple interface emulators; fig. 18-20

illustrating detail of SRMA, col. 8/[0128]] configured to emulate an interface [Firewall]

presented by a storage device and configured to connect to a host; an interface for connecting to

a storage device [the SMRA can have multiple connections for accessing device consoles, col.

4/[0089], such as DCE/DTE, col. 6/[0111]; serial interfaces, fig. 18]; and a processor coupled to

the interface emulators and the interface [Embedded processor, fig. 18-20; col. 8/0128]], the

processor examining commands received through the interface emulator that are generated by the

host and intended for the storage device, the processor allowing [the ability to restrict certain

commands from being executed, col. 3/[0034]] only those of the commands that match a

predetermined set of commands to pass to the storage device via the interface [the CLI proxy can

compare the command to the list of commands. The list could be of commands are allowed/not

allowed to performed, col. 6/[0108]], wherein there may be a different predetermined set of

commands for each interface emulator [dynamically update the rules used for restricting access

to the management interface, col. 2/[0017]; col. 8/[0127]; macro commands, col. 12/[0172]]

and the blocking device is transparent to normal operation of the host and the storage device

[The SRMA is set up to be able to access these network servers over multiple interfaces, col.

6/[0109]; SRMA is capable of supporting different network protocols and DCE/DTE as well,

col. 6/[0111]; since the SRMA is a network proxy Firewall comprising multiple interface

simulations, This feature allows SRMA communicate with any host/server without additional

configuration]. The SRMA is a firewall device or a USB device which has a capability to

communicate with any network devices (flexibility and universal).

Per claim 3, the interface is an integrated device electronics (IDE) interface for a disk drive
[DCE/DTE, col. 6/[0111]].

Per claim 4, the processor receives data back from the storage device in response to the
commands passed to the storage device and forwards the received data to a host through an
interface emulator [col. 8/[0128]].

Per claim 5, when the commands include a capabilities request command relating to the storage
device [authentication/authorization commands requesting connection to the service, col.

6/[0107]] the processor modifies [after user send request access, SRMA utilizes ASC, col. 3/[0040], to hash the username, mode/port using hash algorithm, col. 9/[[0144]] data received from the storage device relating to the capabilities request command to reflect the capability of the storage device as affected by the presence of the blocking device [when user requests access to service network of fig. 1, the user must have the public/private key that matches the public/private key stored in the server that the user requests to access. During authentication authorization access time, public/private key from the storage (server) will be compared (encrypted/decrypted: corresponds to the processor modifies data received from the storage device) to the user's public/private key until they are matched, [col. 9/[0138, 0140, 0142, 0144]. Another word, during authentication process, information passing from user and data returned from the server such as public/private key must be modified by means of encryption in order to protect the confidentially of the information being sent [col. 9/0140]].

Per claim 6, wherein the processor drops those of the commands that do not match the predetermined set of commands, and, after dropping one of the commands, returns status information to a host that indicates that the dropped command was successfully completed [col. 9/[0140; col. 12/[0170]].

Per claim 16, the processor examines feature information from the storage device that relate to features supported by the storage device and the processor modifies any features not supported by the device before making the feature information available to the host [col. 6/[0109]]. The SRMA is a firewall device or a USB device which has a capability to communicate with any network devices.

Per claims 21-22, these claims recite the same limitations as claim 1 with the addition of and long term storage device, multiple hosts which are taught by Carley [servers, fig. 1; Dial-in user/[0098]]. Therefore, these claims are rejected for the same reasons as claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title,
if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would
have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 9 and 17 are rejected under 35 U.S.C 103(a) as being unpatentable over Carley.

Per claim 9, The blocking device further including light emitting diodes (LEDs) coupled to the

processor and configured to transmit status information relating to the status of the blocking

device.

It would have been obvious to one having ordinary skill in the art at the time the invention was

made to use (LEDs) for transmitting status information relating to the status of the blocking

device to alert the administrator the operation status of the blocking device. The LEDs are used

in the art as an indicator for monitoring the status of device and are well-known device.

Per claim 17, Carley teaches the claimed limitations as mentioned above.

Carley does not teach the processor supports a removable drive feature.

It would have been obvious to one having ordinary skill in the art at the time the invention was

made because any computer having beside a fixed hard drive, also a removable drive such as

R/W-CD, USB. Therefore, the processor should have this feature to support the removable drive.

10.   Claims 12-15 are rejected under 35 U.S.C 103(a) as being unpatentable over Carley, and in

view of Kern PN. 6,336,187.

Per claims 12-15, Carley does not teach a user configurable memory connected to the processor,

the user configurable memory storing instructions that define protected areas on the storage

device, the processor dropping or modifying those of the commands that match the

predetermined set of commands. The matching commands are commands that would otherwise modify the protected areas on the storage device. The user configurable memory stores instructions that define unique protected areas on the storage device for each host [col. 5/5-15]. Kern teaches a user configurable memory connected to the processor [106, fig. 1], the user configurable memory storing instructions that define protected areas [table 1, col. 5] on the storage device, the processor dropping or modifying those of the commands that match the predetermined set of commands [col.2/65 to col. 3/10]. The matching commands are commands that would otherwise modify the protected areas on the storage device [col. 2/60-65]. 14. The matching commands are commands that would read the protected areas on the storage device [col. 2/55-57].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Kern to Carley in order to provide:

a) virus protection and firewall security [col. 15/65 to col. 16/5].

b) flexibility of the device in order to modify protected area in case the protected area needs re-assigned new public/private key.

11.   Claim 19 rejected under 35 U.S.C 103(a) as being unpatentable over Carley, and in view of Milliken et al US 2004/0064737.

Per claim 19, Carley teaches the claimed limitations as mentioned above. Carley does not teach the computer virus definition file.

Milliken teaches a computer virus definition for comparison between the information received and the virus definition file [page 5/[0061].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Milliken to Carley to ensure valuable data is protected.

12.   Claim 23 is rejected under 35 U.S.C 103(a) as being unpatentable over Carley, and in view of Watanabe PN. 7,050,042.

Per claim 23, Carley does not teach the interface emulator is an IEEE 1394 connection.

Watanabe teaches IEEE 1394 using in digital camera as firewire connection [col. 2/5-10]

It would have been obvious to one having ordinary skill in the art at the time the invention was

made to use IEEE 1394 for firewire connection. This is because The IEEE 1394 standard defined

in 1995 is an international standard for implementing a cost-effective and high-speed digital

interface [well-known feature]. The IEEE 1394 serial bus provides high-speed data transport of

several hundreds of megabits per second and therefore enables real-time transport required for

digital video data transmission. The IEEE 1394 further provides so-called plug-and-play

function by which devices can be added or removed by users without initial settings. These

advantages cause the IEEE 1394 digital interface to provoke widespread attention as a digital

interconnect for both computer peripherals and consumer electronics including digital video

cameras and digital television sets [col. 2/15-30].

Allowable Subject Matter

13. Claims 2, 10-11 are objected to as being dependent upon a rejected base claims, but would

be allowable if rewritten in independent form including all of the limitations of the base claim

and any intervening claims.

Conclusion

14. **Any response to this action should be mailed to:**

    Under Secretary of Commerce for intellectual Property and Director of the

    United States Patent and Trademark Office

    PO Box 1450

    Alexandria, VA 22313-1450

    or faxed to:

    (571) 273-8300, (for Official communications intended for entry)

    Information regarding the status of an application may be obtained from the Patent

    Application Information Retrieval (PMR) system. Status information for published

Applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http//pak-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc Dinh whose telephone number is (571) 272-4191. The examiner can normally be reached on Monday-Friday 8:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald Bragdon, can be reached on (571) 272-4204.
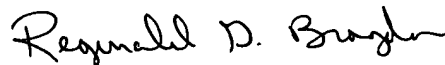
NGOC DINH
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ART UNIT 2189
December 26, 2006

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